

Attorney Docket No.: KUZ0029US.NP
Inventors: Shirai et al.
Serial No.: 10/575,562
Filing Date: April 12, 2006
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REMARKS

Claims 1-7 were pending in the instant application. Claims 1-7 have been rejected. Claims 1 and 7 have been amended. Claim 4 has been canceled. New claims 8 and 9 have been added. Support for these amendments is provided in canceled claim 4 and in teachings in the specification, for example, at page 6, lines 15-17, page 10, lines 16-23 and page 15, lines 6-16. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Objection to Claim 1

Claim 1 has been objected to as the Examiner suggests that the recitation "comprises three ingredients of polyisoprene . . ." is awkward. Thus, in an earnest effort to advance the prosecution and in accordance with the Examiner's suggestion, Applicants have amended claim 1 to include reference characters (a), (b) and (c) before each ingredient. Applicants have also deleted the phrase "the three ingredients of" and placed a colon after comprises. These amendments were made in an effort to provide further clarity to the invention. No new matter has been added.

Withdrawal of this objection is respectfully requested.

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II. Rejection of Claims under 35 U.S.C. 103(a)

The rejection of claims 1-3, 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over Lipman (U.S. Patent Application Publication No. 2004/0243042) as evidenced by Yano et al. (U.S. Patent 5,556,636) and by Tabar et al. (U.S. Patent 4,419,480) has been maintained.

The rejection of claims 1, 4 and 7 under 35 U.S.C. 103(a) as being unpatentable over Lipman in view of Kuniya et al. (U.S. Patent Application Publication No. 2002/0045043) has also been maintained.

Applicants respectfully traverse these rejections.

MPEP 2143.01 sets forth the rationale (recited by the Supreme Court in *KSR International Co. v. Teleflex Inc.*) to support a conclusion that a claim would have been obvious. It is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976);

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Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

All claims recite the limitation of containing a non-solid isobutylene polymer at 1 to 30 parts by weight, excluding 30 parts by weight, per 100 parts by weight of the sum of elements (a), (b) and (c).

Contrary to the Examiner's suggestion, paragraph [0070] of Lipman does not teach the inclusion of liquid polyisobutylene in a range from 1-30 parts relative to the total of the three components. Instead, formulations disclosed by Lipman in the chart at pages 10 and 11 contain a much higher percentage, specifically greater than 100% of VISTANEX LMMS (low molecular weight PIB) relative to the sum of Kraton D1161 (SIS), high molecular weight PIB VISTANEX and KRATON IR305 (polyisoprene).

Secondary references fail to remedy this deficiency.

Accordingly, as all the claimed elements were **not** known in the cited prior art, the cited combinations of art cannot render obvious the instant claimed invention. See MPEP 2143.01.

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Further, claim 1 has been amended to recite the content of the tackifier is in a proportion of 10-80 parts by weight relative to the total weight of (a), (b) and (c). Support for this amendment is provided by claim 4, now canceled.

While Lipman describes at paragraph [0070] inclusion of a tackifier, no numerical range for the tackifier is taught. They do state, however, that "tackifiers used in the prior art hydrocolloid adhesives may make the present composition too sticky." Further, in the chart at page 10 of Lipman, formulations 12, 13, 16, 17, 18 and 19 comprise tackifiers "polyterpene Wingtack 95" and "rosin ester Foral 105" in amounts much lower than recited in claim 1. Accordingly, the modification suggested by the Examiner to include a high proportion of tackifier as described by Kuniya in the composition taught by Lipman is disclosed by Lipman to render the composition unsatisfactory for its intended purpose. Accordingly, there can be no suggestion or motivation to make the proposed modification. See MPEP 2143.01 and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

MPEP 2141.02 is clear, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

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W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Teachings of the primary reference of Lipman clearly lead the skilled artisan away from the inclusion of liquid polyisobutylene in a range from 1-30 parts relative to the total of components (a), (b) and (c) in the composition and the inclusion of tackifier being in a proportion of 10-80 parts by weight relative to the total weight of components (a), (b) and (c). Accordingly, the cited combinations of Lipman, as evidenced by Yano et al. and by Tabar et al. and Lipman in view of Kuniya et al. cannot render obvious the instant claimed invention.

Withdrawal of these rejections under 35 U.S.C. 103(a) is respectfully requested.

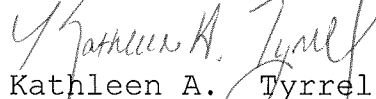
III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent

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allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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Date: **July 7, 2009**

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